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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/062,933	01/31/2002	Jude C. Tan	GAME0102JCT	5172

7590 03/22/2004

S Pal Asija  
7 Woonsocket Ave.  
Shelton, CT 06484

EXAMINER
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LAYNO, BENJAMIN

ART UNIT	PAPER NUMBER
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3712

DATE MAILED: 03/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

### Application No.

10/062,933

### Applicant(s)

TAN, JUDE C.

### Examiner

Benjamin H. Layno

### Art Unit

3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-7, 10 and 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foley et al.

The patent to Foley et al. discloses a game system comprising a plurality of bases 35, Figs. 4 and 5, column 2, lines 69-71. Each of the bases has educational graphics or numerals "1" to "12", column 2, line 72 to column 2, line 1. In Foley's disclosed embodiment, cards 39 numbered from "1" to "12" corresponding to the numerals on the bases, column 3, lines 5-7, are used as a chance device. Foley also discloses that the chance device may dice instead of cards, column 4, lines 1-3. Thus, the numerals "1" to "12" on the bases are reproduced on the sides dice. Foley does not disclose the number of sides on the dice, but it is inherent that Foley uses a 12-sided dice. To play Foley's game each player is given four bases and stands on the bases. The dice is cast to show a numeral. The base having the numeral corresponding to the numeral on the cast dice is eliminated, column 3, lines 9-14. The dice is recast and another base is eliminated, this is repeated until a sole winner is identified standing on the same base numeral as the latest case of the dice, column 3, lines 16-26.

The only feature recited in claims 1-7 and 12-17 that Foley lacks is "N sided dice" and "(P-1) X N bases, where P is the number of players". Foley only recites an embodiment having three players and each player has four bases for a total of twelve bases, and a twelve-sided dice is used. It would have been obvious to a person having ordinary skill in the art that if two players were playing Foley's game, there would have been eight bases and an eight-sided dice would have been used. Determining the number of bases and the number of sides of a dice, would have simply been a manufacturing design choice, which is always obvious in the art.

In regard to claims 4-6 and 14-16, Foley et al. discloses the claimed invention except for the "geometric shapes", "humorous" graphics, and "personalized" graphics set forth in the claims. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Foley's numerical graphics since it would only depend on the intended use of the assembly and the desired information to be displayed.

Further, it has been held that when the claimed printed matter is not functionally related to the substrate, it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of graphic does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel or unobvious functional relationship between the printed matter e.g. ("geometric shapes", "humorous" graphics, and "personalized" graphics) and the substrate e.g. (surface of the bases,

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surfaces of the sides of the dice) which is required for patentability. Furthermore, the only difference between Foley's numerals and the claimed "geometric shapes", "humorous" graphics, and "personalized" graphics, resides in the meaning and information conveyed by printed matter. Such differences are considered unpatentable, *Ex parte Breslow*, 192 USPQ 431.

3. Claims 8-11 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foley et al. as applied to claim 1 and 12 above, and further in view of Sieve.

The patent to Sieve teaches that it is known in the game art to provide differently sided dice e.g. 6-sided, 8-sided, 12-sided, etc. In view of such teaching, it would have been obvious to provide a differently sided dice to Foley's game depending on the number of players participating in the game.

#### ***Claim Rejections - 35 USC § 112***

4. Claims 19 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 19 and 20 are identical. This is indefinite.

#### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The game "Magic Carpets" discloses a game similar to musical

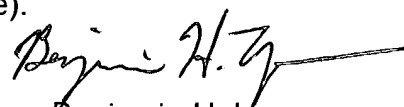
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chairs, however, instead of sitting on chairs, the players stand on sheets of newspaper. The patent to Pederson discloses a game similar to musical chairs, however, instead of sitting on chairs, the players stand on colored areas of a large mat. The patent to Kiss discloses a game comprising a large mat and a plurality of graphical areas on the mat. The game also includes cards having graphics corresponding to the graphical areas. The cards are used as chance devices for moving players on the mat. The patents to Barnes and Edwards disclose games comprising a plurality of bases having graphics. Players stand on a base, and move from base to base.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin H. Layno whose telephone number is (703) 308-1815. The examiner can normally be reached on Monday-Friday, 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703) 308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

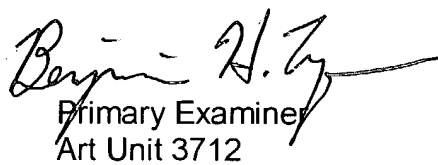
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Benjamin H. Layno

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Primary Examiner  
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bhl